

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: MATSUBARA=2

In re Application of:)	Confirmation No.: 7247
)	
Yasuhiro MATSUBARA et al)	Examiner: Kevin R. Kruer
)	
Appln. No.: 10/576,186)	Group Art Unit: 1794
I.A. No.: PCT/JP04/12087)	
)	
\$371 Date: December 6, 2006)	Washington, D.C.
I.A. Filed: August 24, 2004)	
)	
For: MULTILAYER RESIN FILM, A)	October 15, 2009
RESIN-COATED METAL SHEET..)	

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop Amendment
401 Dulany Street
Alexandria, VA 22314

REPLY TO RESTRICTION AND ELECTION OF SPEICES REQUIREMENTS

Sir:

Applicants are in receipt of the Office Action of September 15, 2009, in the nature of restriction and elections of species requirements, on the basis of purported lack of unity of invention under PCT Rules 13.1 and 13.2.

First, Applicants respectfully request the PTO to acknowledge receipt of Applicants' papers filed under \$119.

Restriction has been required among what the PTO deems as being seven (7) separate inventions. As Applicants must make an election even though the requirement is traversed, Applicants hereby respectfully and provisionally elect Group I, presently claims 1-6, with traverse and without prejudice.

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Applicants believe and respectfully submit that claims 7-12, respectively Groups II-VII, are each sufficiently tied to the elected Group I to meet the requirements for unity of invention under PCT Rules 13.1 and 13.2. Thus, even if the prior art mentioned on page 3 of the Office Action were to require a reduction in scope of the elected Group I claims, corresponding changes could then be made in claims 7-12, whereby there would then be unity of invention in common subject matter of reduced scope. For the record, Applicants are not taking the position that any reduction in scope is necessary at this stage.

Even if the requirement is maintained with respect to Group I, Applicants would continue the traversal among Groups II-VII.

The PTO has also required Applicants to elect between the resin films of claims 3 and 4 as species which define separate inventions under PCT Rules 13.1 and 13.2. As Applicants must make an election even though the requirement is traversed, Applicants hereby respectfully and provisionally elect the resin film species of claim 3, with traverse and without prejudice. The claims which read on the elected species are claims 1-3, 5-7, 9, 11 and 12.

The requirement is traversed on the basis of that the common invention as defined by PCT Rules 13.1 and 13.2 is set forth in claim 1. The species may indeed be patentably distinct from one another, but that criterion does not apply under PCT Rules 13.1 and 13.2.

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Withdrawal of the requirements and examination of all
the claims on the merits are respectfully requested.

Respectfully submitted,

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By

A handwritten signature in dark ink, appearing to read "S. Neimark", written over a horizontal line.

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